

## **REMARKS/ARGUMENTS**

In light of the amendments and arguments presented, Applicant respectfully requests reconsideration of the Non-Final Office Action dated December 18, 2007.

### **I. General Remarks Regarding the Content of this Amendment**

Upon entry of this Amendment, claims 7, 9, 11-20, 30-35 and 38-45 will be pending in this application. Claims 1-6, 8, 10, 21-29, 36 and 37 are cancelled. Through this Amendment, Applicant has amended claims 7, 16, 30, 38-39 and 41. Further, Applicant has added new claims 44 and 45. Support for these changes may be found, for example, at paragraph 31 and 33 of the original specification and further, in original Figures 1-3 and 7. No new matter has been added.

Applicant makes the above noted claim changes for purposes of expediting prosecution and to facilitate the early allowance of this application. This action should not be construed as an admission or acknowledgement that Applicant agrees with any grounds of rejection raised in the Non-Final Office Action of December 18, 2007. Applicant reserves all rights with respect to the original and/or previously submitted claims, including the right to present claims of the same or similar scope in the future (*e.g.*, in a continuing application).

For the reasons described above, Applicant submits that no new matter is included in this Amendment.

### **II. Applicant's Claims Patentably Distinguish from the Cited Art**

#### **A. Applicant's Claims Patentably Distinguish from Kerns**

Claims 7, 8, 10, 11, 16, 17, 19, 30, 31, 33 and 34 stand rejected under 35 U.S.C. § 102 as allegedly anticipated by Kerns et al., U.S. Patent No. 6,922,917 (*hereinafter* “Kerns”). *See* the Dec. 18, 2007, Non-Final Office Action at page 2. Applicant respectfully traverses this rejection and requests reconsideration.

#### **Independent Claim 7**

Applicant’s independent claim 7 recites, *inter alia*, “the securing system includes at least one strap that extends at least partially around a portion of the foot-housing member by extending around a back heel portion of the foot-housing member” (emphasis added). Kearns

does not teach or suggest this claimed feature. The Office alleges that Kearns' lobes 224 are the recited "at least one strap." *See* the Non-Final Office Action at page 2. However, as clearly seen in FIG. 3, the lobes 224 extend across the shoe 200 from the fixed side 216 to the free side 218. Therefore, Kearns does not teach the recited feature of at least one strap that extends at least partially around a portion of the foot-housing member by extending around a back heel portion of the foot-housing member. Accordingly, for at least the reasons described above, Applicant respectfully submits that independent claim 7 patentably distinguishes from Kearns and requests withdrawal of the rejection and allowance of the claim.

**Independent Claims 16 and 30**

Applicant's independent claim 16 recites, *inter alia*, "a secondary closure system for holding the foot in the upper member, wherein the secondary closure system includes a shoelace based securing system, wherein the closure system at least substantially covers the secondary closure system." Kearns does not teach or suggest this claimed feature. The Office alleges that Kearns' canopy 214 with lace 232 and tightening device 234 is the recited securing system. *See* the Non-Final Office Action at page 2. However, assuming without conceding the Office's interpretation of Kearns' canopy 214 with lace 232 and tightening device 234 as the recited securing system, Kearns still does not disclose, "a secondary closure system for holding the foot in the upper member, wherein the secondary closure system includes a shoelace based securing system, wherein the closure system at least substantially covers the secondary closure system." Applicant's independent claim 30 recites similar features as claim 16 and, therefore, similar arguments apply to independent claim 30. Accordingly, for at least the reasons described above, Applicant respectfully submits that independent claim 16 and 30 patentably distinguish from Kearns and Applicant requests withdrawal of the rejections and allowance of the claims.

**B. Applicant's Claims Patentably Distinguish from the Corliss in view of Monti**

Claims 7, 8, 10, 11, 13-17, 19, 21-23, 30, 31, 33, 34, 36, 37 and 42 stand rejected under 35 U.S.C. § 103(a) as allegedly rendered obvious from the combination of U.S. Patent No. 4,845,864 to Corliss (*hereinafter* "Corliss") in view of U.S. Patent No. 5,992,057 to Monti (*hereinafter* "Monti"). *See* the Non-Final Office Action at pages 2-3. Applicant respectfully traverses this rejection and requests reconsideration.

**Independent Claim 7**

Applicant's independent claim 7 recites, "the securing system includes at least one strap that extends at least partially around a portion of the foot-housing member by extending around a back heel portion of the foot-housing member" (emphasis added). The Office alleges that Corliss's outer strap means 54 is the recited "at least one strap." *See* the Non-Final Office Action at page 3. As clearly seen in FIG. 3, the outer strap means 54 extends across the cyclist's shoe 20, not around the back heel portion of the foot-housing member. Therefore, Corliss does not teach or suggest this claimed feature.

Further, Corliss states, "[a]n important feature of the outer strap means is that the large flexible panel 76 extends and is tensioned in a direction transverse to the longitudinal axis of the shoe..." Corliss col. 3, lines 47-49 (emphasis added). Therefore, by stating the importance of the outer strap means 54 extending and being tensioned transverse to the longitudinal axis of the shoe, not only does Corliss fail to teach or suggest the recited feature, Corliss actually teaches away from the recited feature of at least one strap that extends around a back heel portion of the foot-housing member. Accordingly, for at least the reasons described above, Applicant respectfully submits that independent claim 7 patentably distinguishes from Corliss in view of Monti, and, therefore, requests withdrawal of the rejection and allowance of the claim.

**Independent Claim 13**

Applicant's independent claim 13 recites, "a closure system for holding the foot in the foot-housing member, wherein the closure system includes a mesh or braided panel" (emphasis added). As conceded by the Office, Corliss does not teach or suggest this claimed feature. *See* the Non-Final Office Action at page 2. However, the Office cites Monti as disclosing a nylon mesh portion 404. The Office alleges that it would have been obvious to one of ordinary skill in the art to have modified Corliss, in view of Monti, by replacing Corliss's leather flexible panel 76 with nylon mesh. *See Id.* Applicant's respectfully disagree for the following reasons.

First, Corliss was clearly aware that a nylon mesh material could be used in creating the shoe, because Corliss actually uses nylon mesh in the upper 24 of his shoe. *See* Corliss, col. 2, lines 62-65, wherein Corliss states that his cyclist's shoe comprises, "an upper 24 of relatively flexible leather and nylon mesh." Despite using nylon mesh for other parts of his upper 24,

Corliss specifically uses leather for the inner strap means 52 and the outer strap means 54. *See* Corliss, col. 3, lines 13-16 wherein Corliss states, “An important part of the invention comprises two separately adjustable flexible leather strap means namely an inner strap means 52 and an outer strap means 54” (emphasis added). Therefore, by choosing leather over nylon mesh for the two straps 52 and 54, and further, stating the importance of the two straps 52 and 54 to his invention, Corliss actually teaches away from the use of nylon mesh for the inner and outer straps.

Additionally, Applicant notes that Corliss states that the panel 76 of outer strap means 54 must be pulled taut for the desired tightness at the forefoot to be obtained. *See* Corliss, col. 4, lines 4-12. Further, the panel 76 is designed so that the tension can be varied by twisting or sluing the panel 76 while the panel is pulled. *See Id.* Nylon mesh is more flexible than leather and, therefore, replacing the leather with nylon mesh would actually reduce the tautness and tension created by the pulling, twisting and sluing. Therefore, Corliss teaches away from using a nylon mesh for the panel 76. Hence, it would not have been obvious to one of ordinary skill in the art to have modified Corliss with the nylon mesh of Monti. Accordingly, for at least the reasons described above, Applicant respectfully requests withdrawal of the rejection and allowance of the claim.

**Independent Claims 16 and 30**

Claim 16 has been amended to recite “a secondary closure system for holding the foot in the foot-housing member, wherein the secondary closure system includes a shoelace based securing system ...” (emphasis added). The Office concedes that Corliss does not teach or suggest a shoelace based securing system. *See* Non-Final Office Action at page 3. However, the Office alleges that substituting a shoelace based securing system for Corliss’s fastening system would have been obvious to one of ordinary skill in the art. *Id.* at pages 3-4. Applicant’s respectfully disagree. In fact, Corliss specifically teaches away from a shoelace based securing system. As described below, Corliss teaches a cycling shoe that actually eliminates shoelaces.

First, in the background section of his disclosure Corliss describes several problems with shoelaces as securing means for conventional cycling shoes. Corliss states, “with the constant flexing of the soft upper, laces loosen and allow the rider’s foot to slip within the shoe. This is

inefficient and uncomfortable, requiring the rider to stop and retie the laces from time to time.” See Corliss at col. 1, lines 33-37. Therefore, in order to overcome that hindrance caused by the shoelaces, Corliss’s disclosure is directed to a cycling shoe with a securing means that does, “not loosen in use as laces do.” See Corliss at col. 1, lines 46-47.

Secondly, Corliss points out that a shoelace based securing system would require the wearer to use both hands in order to retie the shoelaces. *See Id.* at col. 1, lines 34-36 (wherein the laces require “the rider to stop [to use both hands] and retie the laces”), and lines 45-48. Therefore, in order to overcome that hindrance caused by the shoelaces, Corliss’s disclosure focuses on a securing means that “can be re-adjusted if necessary with one hand without stopping.” *See Id.*

Hence, in view of the above, it is clear that Corliss’s disclosure is directed to a cycling shoe which specifically avoids incorporating a shoelace based securing system, because Corliss is attempting to avoid the potential hindrances that a shoelaces cause in the sport of cycling. Clearly, upon a fair reading of Corliss, one of ordinary skill in the art would not modify Corliss include a shoelace base securing system, because doing so would destroy the intended function of Corliss. It is not *prima facie* obvious to modify a structure disclosed in a reference such that its intended function is destroyed. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Applicant’s independent claim 30 recites similar features as claim 16 and, therefore, similar arguments apply to independent claim 30. Accordingly, for at least the reasons described above, Applicant respectfully requests withdrawal of the rejection and allowance of the claims.

**Dependent Claims 42, 44 and 45**

Applicant’s claim 42 further patentably distinguishes over Corliss. This claim recites that the mesh or braided panel is a substantially continuous panel which completely covers the secondary closure system. First, as discussed above, Corliss does not disclose a mesh or braided panel. Secondly, even assuming the Office’s interpretation that the flexible outer strap 54 is the recited “substantially continuous panel” and the inner strap means 52 is the recited “secondary closure system”, the flexible outer strap 54 does not completely cover the inner strap means 52. In fact, Corliss is specifically designed so that the inner strap means 52 protrudes beyond the flexible outer strap means 54. The inner strap means 52 protrudes beyond the flexible outer strap

means 54 in order for the inner strap means 52 to be adjusted independently of the outer strap means 54. *See e.g.* Corliss, col. 3, lines 55-62. Therefore, Corliss teaches away from a mesh or braided panel that completely covers the secondary closure system. Hence, Corliss cannot teach or suggest this feature of claim 42. Claims 44 and 45 contain similar recitations and therefore, similar arguments apply. Accordingly, for at least the reasons described above, Applicant respectfully requests withdrawal of the rejection and allowance of the claims.

**C. Applicant's Claims Patentably Distinguish from Corliss in view of Heyman**

Claims 7, 8, 10, 11, 13-17, 19, 21-23, 30, 31, 33, 34 and 36-43 stand rejected under 35 U.S.C. § 103(a) as allegedly rendered obvious from the combination of Corliss in view of U.S. Patent No. 1,730,768 to Heyman (*hereinafter* “Heyman”). *See* the Non-Final Office Action at page 4. Applicant respectfully traverses this rejection and requests reconsideration.

**Independent Claims 7, 16 and 30**

The same arguments made above for claims 7, 16 and 30 in regard to Corliss, apply here as well. For the sake of brevity, they will not be recited here in their entirety. However, for the reasons given above, Applicant respectfully requests withdrawal of the rejections and allowance of the claims.

**Independent Claim 13**

Applicant's independent claim 13 recites, “a closure system for holding the foot in the foot-housing member, wherein the closure system includes a mesh or braided panel” (emphasis added). The Office concedes that Corliss does not teach or suggest a braided panel. *See* the Non-Final Office Action at page 4. However, the Office alleges that it would have been obvious to one of ordinary skill in the art to have modified Corliss's panel 76, in view of Heyman, to provide “perforations (i.e. open areas) to provide a light, airy and pleasing appearance.” *See Id.* Applicant respectfully disagrees that such a combination would have been obvious to one of ordinary skill in the art. In fact, as described below, Corliss specifically teaches away from such a combination.

First, Corliss's states that his structure of the outer panel 76 overlying the inner strap means 52 creates a, “smooth aerodynamic contour, providing less wind resistance and fatigue to

the cyclist, especially on long tours approaching one-hundred miles or more per day.” *See* Corliss, col. 4, lines 17-20. Therefore, one of ordinary skill in the art would not substitute Corliss’s leather outer panel 76 with Heyman’s braided material to provide ventilation, because the airy structure of the braided material would actually reduce the aerodynamics of the shoe. Hence, the modification would defeat the purpose of Corliss’s aerodynamic structure.

Second, Applicant notes that Corliss states that the panel 76 of outer strap means 54 must be pulled taut for the desired tightness at the forefoot to be obtained. *See* Corliss, col. 4, lines 4-12. Further, the panel 76 is designed so that the tension can be varied by twisting or sluing the panel 76 while the panel is pulled. *See Id.* Heyman’s interlaced strand structure of a light pliable material, such as paper, would be much more flexible than Corliss’s leather and, therefore, replacing the leather with the interlaced strand structure would actually reduce the tautness and tension created by the pulling, twisting and sluing. Therefore, Corliss teaches away from using an interlaced strand structure for the panel 76. Hence, it would not have been obvious to one of ordinary skill in the art to have modified Corliss with the interlaced strand structure of Heyman.

Third, Corliss’s disclosure is to a competitive cycling shoe. Heyman’s disclosure is to an ornamental shoe with particular reference to an ornamental type of ladies shoes. *See* Heyman at col. 1, line 4. Applicants respectfully submit that one of ordinary skill in the art would not look to modify a competitive cycling shoe with an ornamental type of ladies shoe. The Federal Circuit has consistently held that picking and choosing individual features from a cited reference constitutes impermissible hindsight. “[One] cannot pick and choose among the individual elements of assorted prior art references to recreate the claimed invention.” *Smithkline Diagnostics, Inc., v. Helena Laboratories Corporation*, 859 F. 2d 878, 887 (Fed. Cir. 1988). Hence, it would not have been obvious to one of ordinary skill in the art to have modified Corliss with the interlaced strand structure of Heyman. Accordingly, for at least the reasons described above, Applicant respectfully requests withdrawal of the rejection and allowance of the claim.

**Dependent Claims 42, 44 and 45**

The same arguments made above for claims 42, 44 and 45 in regard to Corliss, apply here as well. For the sake of brevity, they will not be recited here in their entirety. However, for the

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reasons given above, Applicant respectfully requests withdrawal of the rejections and allowance of the claims.

**III. Conclusion**

If the Examiner believes that a telephone conference or a personal interview will be useful to advance the prosecution of this application and/or to place the application in condition for allowance, he is invited to contact the undersigned attorney.

Applicant believes that a 3-month extension of time fee is due for entry and consideration of this Amendment. If, however, the Office determines that any other fees are required, such as fees under 37 C.F.R. §§ 1.16 and/or 1.17, or if an additional extension of time is necessary that is not accounted for in the documents filed with this Amendment, the Commissioner is authorized to debit our Deposit Account No. 19-0733 for any necessary fees, including any necessary extension fees or other fees needed to maintain the pending status of this patent application.

All rejections having been addressed, Applicant respectfully submits that this application is in condition for immediate allowance. Allowance of this application is earnestly solicited.

Respectfully submitted,

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